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09/915,425

07/26/2001

Jordan Pollack

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EXAMINER

MERCHANT, SHAHID R

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

07/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/915,425	Applicant(s) POLLACK, JORDAN	
	Examiner SHAHID R. MERCHANT	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 10, 2008 has been entered.

Status of the Claims

2. This action is in response to the request for continued examination filed on June 10, 2008.

- Claims 1-37 are pending.
- Claims 30-37 have been withdrawn.
- Claims 4 and 18-19 have been amended.

Response to Arguments

3. Applicant is reminded to review section 706.07(b) [R-6] of the MPEP as shown below.

706.07(b) [R-6] Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Art Unit: 3692

> The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114.<

4. Applicant's arguments filed February 11, 2008 (the request for continued examination filed on June 10, 2008 refers back to amendment filed February 11, 2008) have been fully considered but they are not persuasive. Applicant argues that Larson does not teach receiving an item that includes a field for identification, a field which contains a file handle and a field that contains a command specification. Examiner disagrees. When Larson's computer system asks a user to input data on a telephone keypad, the data that the computer system receives from the user is a field of information like identification, a file handle and a command specification. For example, when the computer requests the user to type in a password (identification), the user provides a field of data (i.e., the password) to the computer system. If the data is valid, the user would get access otherwise the access would be denied.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., information should not be entered serially and should not be entered in response to prompts) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Next, Applicant argues that Larson does not teach a rights verifier configured to determine whether or not the sender has privilege to access the stored file corresponding to said file handle. Examiner disagrees. Larson teaches that a

password must be entered and verified before access to a file handle is given.

Examiner notes that the applied reference has been applied assuming basic knowledge of one of ordinary skill in the art and broadest reasonable interpretation of the claims. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Larson, it is within the basic knowledge of a skilled artisan that user's are given certain access privileges depending on their status as a user. Once a password is provided, the system allows access only to areas that the user has privileges to.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant is advised to review column 3, lines 39-40 (Prust) where Prust discusses mobile computers known as hand held PC or personal digital assistants (PDA). In addition, Blackberry's are considered a type of PDA as evidenced by Reference U (see attached PTO-892).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson et al (hereinafter Larson, US 5,825,854) in view of Prust (US 6,714,968 B1).

Re Claim 1: Larson discloses a system for management and manipulation of stored files comprising:

- A receiving portal configured to receive from a sender an item including a first field which contains a user identification (Fig 21 Ref 54; Column 3 line 63-Column 4 line 4), a second field which contains a file handle (Column 5, lines 35-38) and a third field which contains a command specification (Column 4, lines 25-35)
- A storage device containing a file corresponding to said file handle (See Fig 6a Refs 150-152 and Column 7 lines 39-41)
- A rights verifier configured to determine whether or not the sender has privilege to access the stored file corresponding to said file handle (Column 3, line 64-Column 4 line 4)
- A file handle recognizer configured to locate a file handle pattern within the electronic mail item (Column 5, lines 25-38)

- A command executor configured to execute said command specification on the file retrieved from said storage device when the sender is verified to have access rights to the file (See Fax example Figs 6a and 6b and Column 7 line 21-61)

Larson does not explicitly disclose wherein the item is in the form of an electronic mail item from a sender. Prust discloses a method and system for seamless access to a remote storage server utilizing multiple access interfaces executing on the remote server including remote access to virtual data storage via electronic mail (Column 8, lines 9-19). It would have been obvious to anyone of ordinary skill at the time of invention to modify the system of Larson in view of Prust so that a user has further means to remotely access and interact with important data. One would be motivated to do this in order to access stored files from a portable device, such as a wireless Blackberry device, which is capable of sending emails from remote locations. This would be more efficient than using the telephone system of Larson as a user would not have to find a landline telephone, or worry about having cellular phone service for the duration of the procedure.

Re Claim 2: Larson in view of Prust discloses the claimed system supra and Prust further wherein the file handle recognizer is configured for locating conforming file handle patterns within the body of the electronic mail item (Column 7, lines 7-21).

Re Claim 3: Larson in view of Prust discloses the claimed system supra and Prust further includes a user identification system which extracts information from the electronic mail item including the from address, destination address, the subject, the

reply-to, and the body of the electronic mail item to enable verification of the sender as a known user of the system (Fig 7; Column 7, lines 7-34; “user information,” “storage server parses information in order to extract one or more target directories,”).

Re Claim 4: Larson in view of Prust discloses the claimed system supra and Prust further includes a command parser which recognizes and assembles a command out of the information extracted from the electronic mail item (Column 7, lines 30-34)

Re Claim 5: Larson in view of Prust discloses the claimed system supra but does not explicitly disclose wherein the command specification instructs said command executor to delete the file from the storage device. However it was well known in the art at the time of invention to be able to delete a file from a storage device if it was determined that that file was no longer needed. It would have been obvious then to include this feature to the disclosure of Larson in view of Prust as a way to maintain organization of the data store. In this way a user cannot waste valuable storage space on unwanted files and the system can operate more efficiently as it will not have to sift through and keep track of unnecessary data.

Re Claim 6: Larson in view of Prust discloses the claimed system supra and Prust further discloses wherein the command specification instructs said command executor to retrieve the file as an email attachment (Column 7, lines 30-34)

Re Claim 7: Larson in view of Prust discloses the claimed system supra but does not explicitly disclose wherein the command specification instructs said command executor to forward the file to a third party as an email attachment. However it was well known in the art at the time of invention to email a separate party with a file attachment

from data storage. It would have been obvious then to allow the user to simply issue this as a command to the system as a way to eliminate the “middleman” of the process, which in this instance would be the aforementioned user. In stead of the multi-step process of requesting the file from the system, receiving the file in an email from the system and then subsequently creating a new email message to the third party, it would be much more time efficient to simply forward the relevant file directly from the remote storage to the third party at the request of the user.

Re Claim 8: Larson in view of Prust discloses the claimed system supra and Prust further discloses wherein the command specification instructs said command executor to create a newly constructed file handle to the file stored on said storage device (Column 7, lines 26-30). While not explicitly disclosing the step of forwarding to a third party, as was discussed in the rejection of claim 8, it was well known in the art at the time of invention to email a separate party with a file attachment from data storage. It would have been obvious then to allow the user to simply issue this as a command to the system as a way to eliminate the “middleman” of the process, which in this instance would be the aforementioned user. In stead of the multi-step process of requesting the file from the system, receiving the file in an email from the system and then subsequently creating a new email message to the third party, it would be much more time efficient to simply forward the relevant file directly from the remote storage to the third party at the request of the user.

Re Claim 9: Larson in view of Prust discloses the claimed system supra and Larson further discloses wherein the command specification instructs said command

executor to print the file on a fax machine at a specified telephone number (Column 1 line 66-Column 2 line 1).

Re Claim 10: Larson in view of Prust discloses the claimed system supra and Larson further includes at least one of an optical character recognition device (Column 2, lines 17-20), automatic speech recognition device, language translation device (Column 12, Table III), and a file format translation device (Column 7, lines 39-46) associated with the command executor.

Re Claim 11: Larson in view of Prust discloses the claimed system supra but the references do not explicitly disclose wherein the command specification instructs said command executor to convert the file to plain text and email it back to the sender. However it was well known in the art at the time of invention to convert a file to plain text for the purposes of email dissemination. When an email with an attachment is forwarded to a third party, many times the third party might not have the software to view certain types of files. By converting the file into the plain text of an email, the user can send pertinent information to the third party without having to worry about said third parties ability to view the information.

Re Claim 12: Larson in view of Prust discloses the claimed system supra and Larson further discloses wherein the command specification instructs said command executor to convert the file to an audio file and to forward the audio file to a telephone at a specified number (Column 3 line 57-Column 4 line 24).

Re Claim 13: Larson in view of Prust discloses the claimed system supra but does not explicitly disclose wherein the command specification instructs the command

executor to automatically print the file and mail it to a third party. However it was well known in the art at the time of invention to simply print a document for mailing to a third party and would have been obvious to anyone of ordinary skill in the art at the time of invention. Furthermore Larson discloses that a document can be faxed to a specific number by utilizing the command features (Column 4 line 25-54). It was well known in the art that faxing a document to a third party, in essence, involves printing a document at the recipient's location. If however the intended recipient did not have a fax machine it would have been obvious to one of ordinary skill to achieve the same result through the old and well-known conventional mailing system.

Re Claim 14: Larson in view of Prust discloses the claimed system supra but does not explicitly disclose wherein the storage device further includes an automatic deletion timer associated with at least one of the stored files. However automatic deletion timers for storage devices were old and well known in the art at the time of invention and would have been obvious to anyone of ordinary skill in the art. For instance, email applications often have a prompt for auto deletion of pieces of mail that have not been reviewed for a predetermined amount of time. In this way the user does not have to manually go through the storage device in order to clean out unwanted files, as it is likely that any file that has not been viewed in some time is of little value. This saves space and allows for easier management of the storage device.

Re Claim 15: Larson in view of Prust discloses the claimed system supra but does not explicitly disclose wherein the command specification instructs the command executor to change the date of auto deletion of the file. However this step is old and

well known in the art at the time of invention and would have been obvious to anyone of ordinary skill. One would be motivated to do this so a user has control over the deletion of his files. For instance one user may want to save files for up to 6 months to avoid erroneously deleting important files. Another user may feel that a file not viewed for over 2 months is not worth saving and may set the preference likewise. If the user is not allowed to control the auto deletion function, many users would be dissatisfied with the function and may prefer to manually control the deletion of files. This would render the auto-deletion function moot to many users.

Re Claim 16: Larson in view of Prust discloses the claimed system supra and Prust further discloses wherein said file handle is a uniform resource locator (Column 26-30)

Re Claim 17: Larson in view of Prust discloses the claimed system supra and Prust further discloses wherein the storage device is chosen from the group consisting of hard drives (Ref 120), optical drives (Ref 122), random access memories (Ref 115), tape drives, RAID arrays (Column 4, lines 57-59), and storage area networks.

Re Claim 18: Further method claim would have been obvious to implement from previously rejected system claim 1 rejected previously, and is therefore rejected using the same art and rationale.

Re Claim 19: Further computer readable medium claim would have been obvious in order to implement the previously rejected method of claim 18 on the previously rejected system of claim 1 and is therefore rejected using the same art and rationale.

Re Claim 20: Larson in view of Prust discloses the claimed computer readable medium supra and Prust further discloses wherein the computer readable medium is a hard drive (Fig 1, Ref 120)

Re Claim 21: Larson in view of Prust discloses the claimed computer readable medium supra and Prust further discloses wherein the computer readable medium is and optical drive (Fig 1, Ref 122)

Re Claim 22: Larson in view of Prust discloses the claimed computer readable medium supra and Prust further discloses wherein the computer readable medium is a Random Access Memory (Fig 1, Ref 115)

Re Claim 23: Larson in view of Prust discloses the claimed computer readable medium supra and Prust further discloses wherein the computer readable medium is a Read Only Memory (Fig 1, Ref 114)

Re Claim 24: Larson in view of Prust discloses the claimed computer readable medium supra but does not explicitly disclose wherein the computer readable medium is a tape drive. However tape drives are old and well known in the art at the time of invention and would have been obvious to anyone of ordinary skill as a means to implement a software application. A Tape drive have been used for some time to perform this function and is also a simple substitute for things such as a floppy disk or CD-ROM disclosed by Prust (Fig 1, Fig 4, lines 16-23).

Re Claim 25: Further processor and memory claim would have been obvious in order to implement the previously rejected method claim 18 on previously rejected system claim 1 and is therefore rejected using the same art and rationale.

Re Claim 26: Larson in view of Prust discloses the claimed processor and memory supra and Prust further discloses wherein the processor and memory are incorporated into a personal computer (Column 3, lines 37-40)

Re Claim 27: Larson in view of Prust discloses the claimed processor and memory supra but does not explicitly disclose wherein the processor and memory are incorporated into a programmable logic controller. However the step of incorporating a processor into a programmable logic controller is old and well known in the art and would have been obvious to anyone of ordinary skill in the art at the time of invention. One would be motivated to do this in order to program the logic of the computer according to one's own specification and not one set by a manufacturer.

Re Claim 28: Larson in view of Prust discloses the claimed processor and memory supra but does not explicitly disclose wherein the processor and memory are incorporated into a single board computer. However single board computers were old and well known in the art and it would have been obvious to anyone of ordinary skill to include this feature to the system. Furthermore it was well known that many personal computer, laptops and PDA's, such as the ones disclosed by Prust (Column 3, lines 37-40) operate on a single circuit board. Therefore it would have been obvious to permit users with these configurations to perform the methods to reach a broader audience.

Re Claim 29: Larson in view of Prust discloses the claimed processor and memory supra and Prust further discloses wherein the processor and memory are incorporated into an array of network servers. Prust discloses that the users utilize the Internet, which is a worldwide collection of networks that spans hundreds of countries and millions of computers (Column 2, lines 62-64).

Conclusion

8. This is a request for continued examination of applicant's earlier Application No. 09/915,425. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

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